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09/914,280	02/01/2002	Taku Yokoyama	450101-02920	3537

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EXAMINER
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RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/914,280

Applicant(s)

YOKOYAMA, TAKU

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Applicant's amendment of 11/8/06 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 17-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 17-23,25, with respect to the language "*wherein replacement data replaces existing data as the self-controlling robot ages and learns*", the examiner finds this language to be indefinite. The examiner would first like to point out that this language is really directed to the intended use of the system and does not define anything structurally to the system itself; however, it is claim language in totality that must be considered when analyzing the scope of the claims. This language is considered indefinite because a person wishing to avoid infringement would not know whether or not the claim is infringed by just having the system (2 terminals and server), or if the claim is only infringed if one has the claimed system and replaces data as the robot ages and learns. This is not clear.

For claim 24, the examiner has concluded that the recitations of "a step for providing..." and "a step for selling..." are indefinite. What is the actual step that is being claimed? The way the claim language is written, the step of line 2 is "for providing ID information to a mating center", but what does this mean? Is this a positive recitation

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to an actual step of providing the ID information? Does this language have a scope that could allow for the registering step to be satisfied by a person turning on a computer so that they can register information? This would be a step in the process of registering information (because the computer needs to be turned on), so would this satisfy the claimed "registration step for"? The examiner is not clear as to what the scope of the recited steps is. The examiner feels that claiming a step *for doing something* is not the same as claiming the step of actually doing that something. With respect to "a step" for selling the provided ID, can this be the act of advertising the ID information for sale, so that in the future the information can be sold? What is the sales step that is being claimed? Does the step actually require a sale to occur or is the scope of the language "a sales step for" allow for others steps that do not include the actual step of selling? It is not clear what is being claimed.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 17-23,25 are rejected under 35 U.S.C. 102(b) as being anticipated by Tornetta (4870576).

For claim 17, Tornetta discloses an online sales system. Tornetta discloses a *first terminal 100* that is used to register or upload information to a *sales server 200*. The sales server 200 is used to store the information received from terminal 100 and for outputting data to a *second terminal (also 100)*. This system allows a seller to upload data to the sales server, and for a buyer to access the data at a 2<sup>nd</sup> terminal. The *network is 20* in Tornetta. The language “for registering inheritance information associated with one or more robots”, “for purchasing ....information” and “for receiving ....information” is reciting the intended use of the 1<sup>st</sup> terminal, sales server, and the 2<sup>nd</sup> terminal and this language is satisfied by Tornetta because the 1<sup>st</sup> terminal, 2<sup>nd</sup> terminal, and sales server are all fully capable of registering and receiving the claimed robot type of data. The “robot data” is not positively claimed and is not even part of the system itself. The robot data is only being recited as the kind of data that is intended to be registered and sold, etc.. The limitation directed to the inheritance information has been considered but does not change the scope of the claim because all that is structurally claimed is a first and second terminal and a server. The claim is reciting that the intended use of the system is for inheritance information of robots but this recites no further structure to the claimed system so as long as Tornetta is capable of using robot data, which it is, then the claim is anticipated by Tornetta. The examiner notes that it has been previously held that “A *recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in*

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*order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963).* In the instant case Tornetta is fully capable of being used to upload and sell "robot data" as claimed. Tornetta discloses the system as claimed and is capable of being used with robot data as claimed.

For claim 18, the mating means for combining a plurality of pieces of inheritance information is considered to be satisfied by Tornetta. This is because Tornetta discloses in column 8, lines 23-31 that a file is created that lists the serial numbers of properties that satisfy the search criteria. This file is made by combining a plurality of pieces of data (serial numbers) into one file. Information from separate files is merged into one file, which satisfies what is claimed.

For claims 18-21, with respect to the recitations about what kind of purchase is happening and what the inheritance information is, they are the intended use of the system and are satisfied by the fact that Tornetta is capable of being used with robot data as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as

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compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

For claim 22, the sales server 200 accepts data from and can transmit data to terminals 100 as claimed. The claimed means has a recited function of "for presenting registered inheritance information to said first terminal and said second terminal", and Tornetta is fully capable of and does present information as claimed.

For claim 23, the memory means is satisfied by the fact that Tornetta discloses that information is stored on a database by sales server 200. A database is a means to store information. As stated previously the type of data will not receive patentable weight because it is considered as non-functional descriptive material directed to the intended use of the system (i.e. the kind of data the system is intended to hold and display to users).

For claim 25, Tornetta discloses a sales server as claimed. The registration means is interpreted to be the software/hardware that saves data to the database of the sales means 200. The server of Tornetta is capable of being used with robot data and can be used in the intended use manner as recited by applicant. All that is claimed is a registration means and a sales means, with the intended use of these means being for use with robot data.

5. Claim 17,19-23,25, are rejected under 35 U.S.C. 102(e) as being anticipated by Gabai et al. (6160986). Gabai discloses an online system for the downloading of robot personality type data. See col. 11, lines 8-20. The 1<sup>st</sup> terminal is considered inherent to

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Gabai because the robot data saved on the remote server has to get on the server by a 1<sup>st</sup> terminal (it has to be put on the server and saved initially, this is necessarily 100% present) so that the 2<sup>nd</sup> terminal 60 can download the data from the server. A network is inherent in Gabai because a network is necessary to be able to download the data. You cannot download the data without a network. With respect to the intended use of the device such as it being for a "sale" of data, describing a type of purchase, and for storing specific type of data, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use (which in the instant case Gabai is fully capable of the intended use limitations) then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The newly added limitation directed to the inheritance information and data that is replaced has been considered but does not change the scope of the claim because all that is structurally claimed is a first and second terminal and a server. The claim is reciting that the intended use of the system is for inheritance information of robots but this recites no further structure to the claimed system.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadakuni (6594649).

For claims 17,18,20,21,23,25, Sadakuni discloses a robot device that has personality data downloaded into the device from an external device such as a remote computer (registration means of claim 25). In column 13, lines 1-32, Sadakuni discloses that robot personality data can be downloaded (to a 2<sup>nd</sup> terminal) to the robot device from the Internet (Internet is the sales means of claim 25). Sadakuni discloses that by having the ability to get data from the Internet, data from multiple devices can be cross bred (mating means) to create a new system with a new personality. This cross breeding inherently requires uploading of robot data from a 1<sup>st</sup> terminal to make the data available via the Internet so it can be cross bred (to replace previous robot data). A network is inherent in Sadakuni because a network is necessary to be able to download the data. Sadakuni does not disclose a "server". It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a server in the system of Sadakuni so that the robot data can be stored and accessed via the Internet. The use of a server to manage and store data on the Internet is very well known and would have been obvious to one of ordinary skill in the art just based on the skill level of one of ordinary skill in the art. The use of a "server" is considered to be something that is within the collection of knowledge that one of ordinary skill in the art would be in

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possession of. With respect to the intended use of the device such as it being for a "sale" of data, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use (which in the instant case is fully capable of the intended use limitations) then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The newly added limitation directed to the inheritance information has been considered but does not change the scope of the claim because all that is structurally claimed is a first and second terminal and a server. The claim is reciting that the intended use of the system is for inheritance information of robots but this recites no further structure to the claimed system.

For claim 19, Sadakuni discloses a recordable medium in column 13.

For claim 22, the registration means is considered to be present in Sadakuni.

For claim 24, Sadakuni discloses the invention substantially as claimed.

Sadakuni discloses that robot personality data can be stored for downloading on/from the Internet. This satisfies the claimed "step for providing to a mating center, ID information and inheritance information of a self-controlling robot". Sadakuni discloses that by having the ability to get data from the Internet, data from multiple devices can be cross bred (mating means) to create a new system with a new personality. This cross breeding inherently requires uploading of robot data from a 1<sup>st</sup> terminal to make the data

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available via the Internet so it can be cross bred (to replace previous robot data).

Sadakuni does not disclose the "selling" of the robot personality data. It would have been obvious to one of ordinary skill in the art at the time the invention was made to sell the robot data so that one can make money. Prior to the filing date of this application it was in the public domain that various companies are selling robots for personal use where the robots possess a personality determined by personality data. In view of this fact and in view of the fact that one can find just about everything for sale nowadays the concept of "selling" robot personality data (noting that robots that use the data are already being sold in the retail marketplace) is considered obvious to one of ordinary skill in the art.

8. Applicant's arguments filed 11/08/06 have been fully considered but they are not persuasive.

With respect to the 112,2<sup>nd</sup> paragraph rejection to claim 24, applicant still has not amended the claim language in any kind of meaningful manner to overcome the rejection and has not provided any kind of traversal on the merits. The rejection will be maintained and the position of the examiner has not changed with respect to this claim due to the language "a step for". The claim is indefinite and no persuasive argument has been presented that overcomes the rejection. The amendment does not address the core issue at hand.

With respect to the Tornetta reference, the Gabai reference, and the Sadakuni reference, applicant continues to argue that the language in claim 17 defining the kind

of robot data is not found in the prior art. *With respect to the article claims, the position of the examiner is that the robot data is only claimed as the intended use of the system and the "robot data" limitations define no further structure to the system itself, so the argument is still non-persuasive.* As stated previously, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). With respect to claim 24, the argument for this method claim is based on the argument for claim 17, which is found as non-persuasive.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL  
PRIMARY EXAMINER